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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,222	07/10/2002	Michael John Gait	2224/OK248	9617

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New York, NY 10150-5257

EXAMINER

AUDET, MAURY A

ART UNIT PAPER NUMBER

1654

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,222

Applicant(s)

GAIT ET AL.

Examiner

Maury Audet

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-58, 61-75, 77 and 84-92 is/are pending in the application.
- 4a) Of the above claim(s) 36-58, 61, 64-75 and 77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62, 63 and 84-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's response of 8/16/2005 is acknowledged. Applicant's election without traverse of Group VII, claims 62-63, and 84-92, in the reply filed on 02/14/2005 is again acknowledged. As well as Applicant's election of the species of claim 84. Applicant has amended the claims to now limit M2 from that of a "residue of a molecule bearing an hydroxyl group", to "M2 compris[ing] an oligonucleotide residue" [of which a hydroxyl group is therein]. Based on Applicant's amendment, a new search of the prior art was necessary and art found reading upon the elected compound. Therefore, this action is made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 62,63 and 84-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Soukchareun et al. (Bioconjugate Chem., 1998, 9, 466-475; also cited in Applicant's specification page 2, lines 15-18).

Soukchareun et al. teach the elected invention, namely a compound of formula IV consisting of peptide residue (cysteine) conjugated to an oligonucleotide, formed on a solid support (abstract, page 466, entire document).

Applicant's arguments on specification page 2 that Soukchareun et al. (as well as other similar teachings) produce the same peptide-oligonucleotide conjugates, though through different methods is noted. However, the elected invention is to the end product/compound, not methods of making, and absent evidence to the contrary, Soukchareun has produced the same end product/compound

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

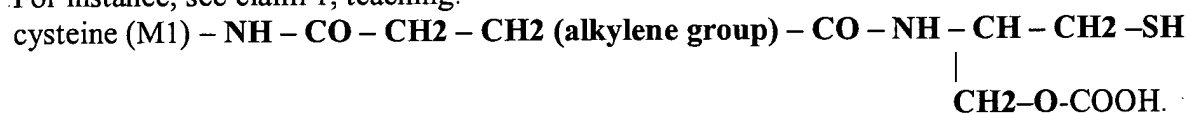
Claims 62,63 and 84-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soukchareun et al. (Bioconjugate Chem., 1998, 9, 466-475; also cited in Applicant's specification page 2, lines 15-18) in view of Constancis et al. (US 5,496,872).

Soukchareun et al. is discussed above. The text of Soukchareun et al. teach an end product of Applicant's elected invention, with a myriad of different chemical formula's at arriving at said end product.

Constancis et al. was discussed in the previous action. Constancis et al. teach a cysteine-cysteine conjugate, comprising a chemical compound of formula (VI), wherein M1 is a peptide residue, M2 is a residue of a molecule bearing a hydroxy group; A is an alkylene/arylene group; B is a linker or X-J; X is a residue of a functional group capable of reacting with a hydroxy group; J is an alkylene/arylene group; and D is a C1-4 alkylene group or C3-C12 arylene group.

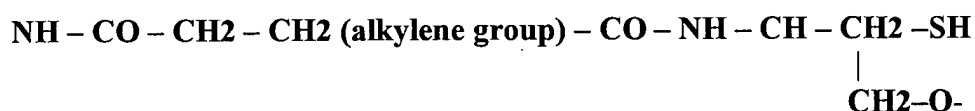
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For instance, see claim 1, teaching:



See also Example 8 (4); Example 9 (6), (7); Example 10 (8).

If not expressly shown by chemical structure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a linking structure of:



between the M1 peptide residue and M2 oligonucleotide residue of Soukchareun et al., because Constancis et al. teach the same linking structure in standard peptide residue linking and Soukchareun et al. teach the linking of a peptide residue to an oligonucleotide under the like-kind standard chemical synthesis, and the selection of the linking structures therebetween is merely a matter of routine optimization by one of ordinary skill in the art, absent evidence to the contrary (and applicable only if Soukchareun et al. does not already teach the above or obvious variations thereof, it their own teaching).

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA, 10/28/2005



**CHRISTOPHER R. TATE
PRIMARY EXAMINER**